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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/583,382	06/19/2006	Toshiharu Arishima	2006_0961A	3109
513 7590 09/21/2009 WENDEROTH, LIND & PONACK, L.L.P. 1030 15th Street, N.W., Suite 400 East Washington, DC 20005-1503				
EXAMINER				
CHONG, YONG SOO				
ART UNIT		PAPER NUMBER		
1617				
MAIL DATE		DELIVERY MODE		
09/21/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/583,382

**Applicant(s)**

ARISHIMA ET AL.

**Examiner**

Yong S. Chong

**Art Unit**

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 4-13 is/are pending in the application.
- 4a) Of the above claim(s) 4-7 and 10-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8 and 9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date: \_\_\_\_\_

**DETAILED ACTION**

***Status of the Application***

This Office Action is in response to applicant's arguments filed on 6/24/09.

Claims 1-3, 14-19 have been cancelled. Claims 4-13 are pending. Claims 4-7, 10-13 have been withdrawn. Claims 8-9 are examined herein.

Applicant's arguments have been fully considered and found persuasive to withdraw all rejections of the last Office Action. In view of the response filed on 6/24/09, PROSECUTION IS HEREBY REOPENED. To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

The following new rejections will now apply.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 8-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The limitation "containing the active ingredient LUU type and UUL type triacylglycerols" renders the claim indefinite as to whether one compound or a combination of compounds are being claimed. While the term "active ingredient" refers to one compound, the term "LUU type and UUL type triacylglycerols" refers to more than one compound.

Claims 8-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The limitation "LUU type and UUL type triacylglycerols" renders the claim indefinite because it is the same compound. Reading the long chain fatty acid moieties left to right or right to left does not change the structure of the compound.

Claims 8-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The limitation "(i.e., asymmetric triacylglycerols composed of L which represents a long-chain saturated fatty acid having from 16 to 22 carbon atoms and U which represents an unsaturated fatty acid having from 16 to 22 carbon atoms)" renders the claim indefinite because it is not clear whether the limitation

in parenthesis limits the scope of the term "triacylglycerols" or is a preferred embodiment or example.

Claims 8-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Dependent claim 9 does not further limit claim 8 since both claims recite the asymmetric triacylglycerol as the active ingredient with the same scope.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 8-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Daubert et al. ("Unsaturated Synthetic Glycerides. II. Unsymmetrical Dioleo-monosaturated Triglycerides," *Journal of the American Chemical Society*, 1943, 65, 2144-2145).

Minor et al. discloses the synthesis of unsymmetrical dioleo-monosaturated triglycerides. Preferred embodiments include 1-stearyl-2,3-diolein and 1-palmityl-2,3-diolein (Table 1).

The limitations drawn to "lipase inhibitor" or "lipase absorption inhibitor" are inherent properties of the compound. Applicant is encouraged to show factual evidence that the same compound does not possess these properties.

"Products of identical chemical composition can not have mutual exclusive properties." Any properties exhibited by or benefits from are not given any patentable weight over the prior art provided the composition is inherent. A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the disclosed properties are necessarily present. *In re Spada*, 911 F.2d 705, 709, 15 USPQ 1655, 1658 (Fed. Cir. 1990). See MPEP 2112.01. The burden is shifted to the applicant to show that the prior art product does not inherently possess the same properties as the instantly claimed product.

Claims 8-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Minor et al. ("n-Octadecenoic acids. V. The polymorphism of some elaidoyl and petroselaidoyl triglycerides," *Journal of the American Chemical Society*, 1953, 75, 2685-2686).

Minor et al. gives physical properties for 2-stearyl dielaidin (abstract), otherwise known as 9-Octadecenoic acid, 2-[(1-oxooctadecyl)oxy]-1,3-propanediyl ester.

Claims 8-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Harwood (US Patent 3,492,130).

Harwood teach the synthesis of the di-unsaturated triglyceride of formula II, where S represents a saturated acyl radical of 16-18 carbons and U represents an unsaturated acyl radical of 16-18 carbons (col. 1, lines 60-71). Preferred embodiments are 1-stearo-2,3-diolein or 1-palmito-2,3-diolein (col. 2, lines 51-59).

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yong S. Chong whose telephone number is (571)-272-8513. The examiner can normally be reached on M-F, 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, SREENI PADMANABHAN can be reached on (571)-272-0629. The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Yong S. Chong/  
Primary Examiner, Art Unit 1617

YSC